Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-826

ELLSWORTH H. MOSHER,
Petitioner

v.

HON. HOWARD T. MARKEY
HON. GILES S. RICH
HON. PHILLIP B. BALDWIN
HON. DONALD E. LANE
HON. JACK R. MILLER
The Chief Judge and the Associate Judges of the United States Court of Customs and Patent Appeals

and

CHIRANJIB K. SARKAR,
Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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November, 1978

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Petitioner respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Customs and Patent Appeals ("C.C.P.A.") entered on August 24, 1978 in the case entitled *In the Matter of the Petition of Ellsworth H. Mosher.*

OPINION BELOW

The opinion of the C.C.P.A. is not yet officially reported. It is reprinted hereinafter in Appendix A. An unofficial report appears at 199 U.S.P.Q. ? ?.

JURISDICTION

The judgement of the C.C.P.A. (App. 1a) was entered on August 24, 1978, and this petition is being filed within ninety days thereafter.

The jurisdiction of this Court is invoked under 28 U.S.C. §1256.

The basis for federal jurisdiction in the court below was petitioner's request (App. 4c) for a certified copy of a specified portion of the record of a patent appeal then pending before the court, in accordance with C.C.P.A. Rule 1.2(b).

QUESTION PRESENTED

Whether the First, Fifth, Ninth or Tenth Amendments to the Constitution are violated by the C.C.P.A., an Article III federal appellate court, by that court's sealing the court record of a direct patent appeal and barring any public attendance at the statutorily authorized oral hearing, where that court has heretofore uniformly had open records and open hearings for all patent cases since it was established.

THE CONSTITUTIONAL, STATUTORY AND RULE OF COURT PROVISIONS INVOLVED

The constitutional provisions are the following:

The First, Fifth, Ninth and Tenth Amendments to the Constitution.

The statutory provisions are the following:

The Act of July 4, 1836, 5 Stat. 117, §16

The Act of March 3, 1839, 5 Stat. 353, §11

The Act of March 2, 1929, Public No. 914, 70th Congress, §2(a)

28 U.S. Code §§211, 1256 and 2071

35 U.S. Code §§122 and 141-144

The court rules are the following:

C.C.P.A. Rules 1.2(b) and 5.13(g)

The foregoing, or at least the relevant portions thereof, are reproduced hereinafter in Appendix D (App. 1d).

STATEMENT OF THE CASE

On May 11, 1978, the C.C.P.A. handed down a landmark decision in the direct patent appeal *In re Sarkar*, C.C.P.A. Appeal No. 78-554, pursuant to a motion by Sarkar under C.C.P.A. Rule 5.13(g) to seal the record and to hear oral argument with respect thereto *in camera*

> "so that material disclosed in the involved patent application [of Sarkar] may be retained, in the event of an adverse decision, as a trade secret".

The court granted the motion. The court's opinion is reported at 575 F.2d 870, 197 U.S.P.Q. 788. It is reprinted hereinafter in Appendix B (App. 1b).

On June 8, 1978 petitioner filed a motion (later designated by the court as a petition) requesting the court to vacate or overrule its decision of May 11, 1978 so that petitioner could secure copies of portions of the Sarkar record on file with the court, or alternatively, for modification of the court's decision at least to the extent of authorizing petitioner to be present during oral argument and to instruct the Clerk of the court to give petitioner reasonable notice in advance of the date set for the oral hearing (Appendix C).

Simultaneously therewith, petitioner filed a letter order (App. 4c) for a certified copy of certain portions of the record of Sarkar, and tendered a sum of money more than sufficient to cover the cost of the desired certified copy.

On August 24, 1978, the C.C.P.A. handed down its decision denying the petition. See Appendix A (App. 1a).

A motion for a stay of further proceedings in *Sarkar* until this Court could act on a petition for certiorari was denied by the CCPA on November 2, 1978. The motion and the denial are reproduced in Appendices E and F.

REASONS FOR GRANTING THE WRIT

With a single stroke of the pen, the C.C.P.A. last May shattered an unbroken tradition of *139 years* of open court records and open court hearings in direct appeals from the Patent Office. This Court is now urged to undo that action via certiorari to the C.C.P.A.

Never before in the history of direct appeals from the United States Patent and Trademark Office ("Patent Office") has the record in the court been sealed or a closure order made. The court below itself referred to this as an "extraordinary action of the court" (App. 5b).

This action of the C.C.P.A. is highly prejudicial to the long-established custom of the courts in this country to remain generally free and open to its citizens so that the public may enjoy, and continue to enjoy, the blessings of these United States in the respects indicated that were all too often denied to citizens of other lands[1] up until modern times—and sometimes even in very recent years.[2]

This right of free access to the court is so very fundamental and precious that it ought not to be sacrificed in favor of the private interest of any particular appellant before the C.C.P.A.

It should be said that petitioner is in no way connected with Sarkar, either directly or indirectly, and has no interest (commercial or otherwise) in the particular subject matter involved in Sarkar's appeal.

The Sarkar motion to seal, etc., is contrary to the public's ancient common law "right to know" what is going on in its courts.

The principle was firmly established long ago in this very kind of direct appeal from the Patent Office in *Ex parte Drawbaugh*, 2 App.D.C. 404 (1894), and *In re Sackett*, 30 C.C.P.A. 1214, 136 F.2d 248 (C.C.P.A. 1943). See also *In re Mosher*, 45 C.C.P.A. 701, 248 F.2d 956 (C.C.P.A. 1957).

In its opinion in the case at bar, the C.C.P.A. emphasized the fact that Sarkar filed his motion *simultaneously* with the filing of the Patent Office record (App. 4b). That difference in timing does not require a result differing from the cases mentioned above. It does not, as a matter

[1] One has only to think of the English Courts of the Star Chamber and the courts of the Spanish Inquisition.

[2] In the October 1978 issue of the American Bar Association Journal, see J.A. Cohen, "Will China Have a Formal Legal System" at p. 1510, and R.B. Ginsburg, "American Bar Association Delegation Visits the People's Republic of China", at p. 1516.

of *law*, change the ancient "balance" between the interest of the public on the one hand and the private interest of this particular appellant Sarkar on the other.

A direct appeal to a court (in the earliest statute, to the "Chief Justice" individually) in a case of the kind here involved has been provided for since the Act of March 3, 1839, 5 Stat. 353,[3] although slightly earlier a remedy by bill in equity was permitted in the special case of interference "with an unexpired patent previously granted". §16 of the Act of July 4, 1835, 5 Stat. 117. See P. J. Federico, *Evolution of Patent Office Appeals*, 22 J.Pat.Off.Soc. 838-64 and 920-49 (1940).

No instance is known where during the intervening 139 years a court granted a motion to seal the record in a direct appeal of the kind here involved. Only one case comes to mind where secrecy was imposed not in a direct appeal from the Patent Office but in a trial *de novo* action under 35 U.S.C. §145. See *Isenstead v. Watson, Comm. of Patents*, 157 F.Supp. 7 (D.C. D.C. 1957). Cf. what seem to be certain interesting dicta in *Montgomery et al v. Kingsland, Comm. of Patents*, 83 U.S. App. D.C. 66, 166 F.2d 953 (1948) at 956.

Accordingly, this is *a case of first impression* in this Court.[4] Apart from a passing remark obviously not necessary to the decision in *Ex parte Uppercu*, 239 U.S. 435 (1915)[5], no instance is known where this Court has had

[3] The first such direct appeal was *In re Kemper*, Fed.Cas.No. 7687 (Cir. Ct., D.C., May 1841). That appeal was decided by "Chief Judge" Cranch of the Circuit Court.

[4] It was recognized as a case of first impression in the court below. See App. 3b.

[5] In *Uppercu*, which was an original petition for mandamus to enforce the right of access to certain depositions and exhibits on file in, but sealed by order of, a Federal District Court, this Court remarked that

(footnote continued)

occasion to consider the important question presented by this petition.

The only contrary ruling in a lower federal court seems to be that of *In re McLean*, Fed.Cas.No. 8877 (C.C. Ohio, 1879)[6] where the court remarked that:

> "It is, therefore, very clear to my mind that the unlimited right of a citizen of the United States to inspect and examine all the records and papers belonging to the court does not exist."

However, an interesting footnote reveals that,

> "The judges afterwards granted *ex gratia* what they ruled the petitioner was not entitled to, as a matter of law."

There is authority indicating that secret court hearings in colonial days were frowned upon. See the Charter of Fundamental Laws of 1676 of West Jersey which indicated that:

> "in all publick courts of justice for tryals of causes, *civil* or criminal, any person or persons, inhabitants of the said Province may freely come into, and attend the said courts, and hear and be present, at all or any such tryals as shall be there

(footnote continued)

> "[n]either the parties to the original cause nor the deponents have any privilege, and the mere unwillingness of an unprivileged person to have the evidence used cannot be strengthened by such a judicial fiat as this, forbidding it, however proper and effective the sealing may have been as against the public at large."

As Mr. Justice Holmes' opinion clearly reveals, however, the petitioner in *Uppercu* was an interested person and not merely a member of the "public at large", and so the concluding clause of the quoted portion is pure dictum. Note that the requested access was granted.

[6] Cited and therefore already considered by the court below in *Mosher*, supra. This same case was reported elsewhere as *In re Cincinnati Enquirer*, Fed.Cas.No. 2719. It was not a patent case.

> had or passed, that justice may not be done in a corner nor in any covert manner . . . [emphasis supplied]." 5 F. Thorpe, The Federal and State Constitutions, Colonial Charters, and Other Organic Laws of the States, Territories and Colonies Now or Heretofore Forming the United States of America 2551 (1909)."

In colonial Pennsylvania it was declared in 1682 that "all courts shall be open, and justice shall neither be sold, denied nor delayed." Id. at 3060.

In *United States v. Cianfrani*, 573 F.2d 835 at 851 (3rd Cir. 1978), the court remarked that:

> "Public confidence cannot long be maintained where important judicial decisions are made behind closed doors and then announced in conclusive terms to the public, with the record supporting the court's decision sealed from public view".

In Wigmore's classic treatise on the law of evidence (Chadbourn's revision), Vol. 6, 1976, we find at page 438 the following comment:

> "In all experience, secret tribunals have exhibited abuses which have been wanting in courts whose procedure was public."

and

> "The educative effect of public attendance is a material advantage. Not only is respect for the law increased and intelligent acquaintance acquired with the methods of government, but a strong confidence in judicial remedies is secured which could never be inspired by a system of secrecy."

At page 439, Wigmore quoted from a 1913 divorce case in Great Britain where Earl Loreburn remarked as follows:

> "I cannot think that the High Court has an unqualified power in its discretion to hear civil proceedings with closed doors. The inveterate rule is that justice shall be administered in open Court."

In reporting a decision by the House of Lords in a case originating from Canada some forty years ago, it was remarked that:

> " . . . publicity is the authentic hall-mark of judicial as distinct from administrative procedure . . . The actual presence of the public is never of course necessary. Where Courts are held in remote parts of the Province, as they frequently must be, there may be no members of the public available to attend. But even so the Court must be open to any who may present themselves for admission. The remoteness of the possibility of any public attendance must never by judicial action be reduced to the certainty that there will be none." (loc. cit. at 440).

Wigmore arrives at the following conclusion:

> "In general, therefore, and as a rule, a trial must be conducted in such a way as to allow the access of the general public". (loc. cit. at 441).

In a footnote to one of the briefs of *amici curiae*[7] in a case now pending before this Court (*Gannett Co., Inc. v. Hon. Daniel A. DePasquale*, No. 77-1301), *amici* at page 12 remark in a footnote that

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[7] The Deadline Club; The New York City Chapter of the Society of Professional Journalists, Sigma Delta Chi; and The Society of Professional Journalists, Sigma Delta Chi.

> "So important is public knowledge of the activities of the judiciary that it could be argued that access to this information [from which the press was excluded] by the public is an extra-constitutional right, i.e., one never surrendered to federal authority but rather is reserved for the people, as recognized under the Ninth and Tenth Amendments. *Griswold v. Connecticut*, 381 U.S. 479 (1964)."

The action of the court below is directly contrary to the spirit of the day which seems to be moving towards greater "openness" in governmental operations. One need only refer to the well known "Sunshine Laws" which have proliferated in the last few years. See the numerous laws referred to under that heading in Shepard's "Acts and Cases by Popular Names", 1978 Supplement, page 354, where the statutes of a large number of states are cited after initial reference to the federal Freedom of Information Act.

If a practice of 139 years of openess is to be departed from in respect of direct appeals from the Patent Office, this should only be done via unmistakable mandate from the Congress and not by the court below.

The Applicable Patent Statute Precludes Secrecy in the C.C.P.A.

The decision of the C.C.P.A. is untenable because the decision to seal or not to seal the record in an *ex parte* patent appeal of the kind here involved is not a matter for the discretion of the court. This is clear from a consideration of the overall statutory scheme envisioned by the Congress for dealing with patent applications in and from the Patent Office.

Thus, in the Patent Act of 1952, the specific statutory mandate regarding the confidential status of patent applications[8] is embodied *exclusively* in 35 U.S.C. §122, which reads as follows:

> "Applications for patent shall be kept in confidence *by the Patent and Trademark Office* and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." [Emphasis added.]

The Congress could just as easily have included in §122 (or elsewhere in the statute) a reference to the courts to which appeals are taken from the Patent Office, had it intended secrecy to be applicable to C.C.P.A. records relating to applications for patent.

The statutory mandate governing the proceedings in direct *ex parte* patent appeals to the C.C.P.A. is embodied in §§141-144. But whereas §122 positively states that "applications for patent shall be kept in confidence by the Patent and Trademark Office, etc.", *there is no corresponding language regarding secrecy in any of §§141-144 of the same statute.*

It follows that the sealing of the record, etc., cannot be justified under §§141-144 because language similar to that found in §122 does not appear in §§141-144. The omission should be regarded as significant. This Court has made the application of the principle clear in *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5 (1939). There at page 14 this Court said that:

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[8] For a recent detailed history of the rule of secrecy in the Patent Office—going back to 1854—see *Sears v. Gottschalk, Commissioner*, 502 F.2d 122 (4th Cir. 1974) at 128-132. The practice embodied in the earlier Patent Office rules was not incorporated into the patent statutes until nearly a century later (1952).

> "[w]e have no way of knowing whether the discrimination results from inadvertence *or some undisclosed legislative policy*, but, in order to redress the disadvantage under which one in the petitioner's situation suffers, *we should have to read into the law words which plainly are missing. We cannot thus rewrite the statute.*" [Emphasis added, footnote omitted.]

The C.C.P.A. should not be permitted to, in effect, rewrite §§141-144 to track §122 by the expedient of promulgating a new rule of court not in harmony with the controlling statute. The statutory authority to do so is conspicuous by its absence.

The rule-making power of any federal court is by statute relatively restricted. Thus, 28 U.S.C. §2071 specifically states that

> "The Supreme Court and all courts established by Act of Congress may from time to time prescribe rules for the conduct of their business. Such rules *shall be consistent with Acts of Congress* and rules of practice and procedure prescribed by the Supreme Court." [Emphasis added.]

No court is entitled to regard itself as completely untrammeled in this regard. The decisions in this Court are uniformly to that effect, *Heckers v. Fowler*, 2 Wall. (69 U.S.) 123 (1864); *Washington-Southern Navigation Co. v. Baltimore & Philadelphia Steamboat Co.*, 263 U.S. 629, 635-6 (1924); *Johnson v. Manhattan Railway Co.*, 289 U.S. 479, 503 (1933).

From Earliest Times Up Until May of this Year It Was Always Supposed That C.C.P.A. Records in Direct Patent Appeals were Open to the Public

At the time of the passage of the Patent Act of 1952 it was generally thought by all concerned that the records of

the C.C.P.A. in direct *ex parte* appeals from the Patent Office were freely available to any member of the public. See the *Commentary on the New Patent Act* by P. J. Federico[9] at 35 U.S.C.A. at pages 1 et seq (1954). It is of course well known that Mr. Federico was very active in the able group that assisted in drafting the various bills that finally became the Patent Act of 1952.

During the First Judicial Conference of the C.C.P.A.[10] held on April 30, 1974, Mr. Joseph Nakamura, the Solicitor of the Patent Office, remarked (page 223) that

> "the *in camera* proceeding rule is in essence a conflict with the policy of open public records of the court."

The Patent Office has long believed—and has so informed the public—that records in the C.C.P.A. relating to direct patent appeals are freely available to the public. In its semi-official *Manual of Patent Examining Procedure*, a publication of the Patent Office, §1216.01, page 220.7 (Revision No. 52, April 1977), it is specifically stated that

> "[s]ince a transcript of the application [for patent] becomes a part of the [C.C.P.A.] court record, it may of course be inspected there by anyone, *In re Mosher*, 45 C.C.P.A. 701; 115 USPQ 140."

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[9] His exact words on the point (at p. 36) are:
"In the case of an appeal to the court (section 141) the application will become available to the public since a copy is made of record in the court *and the court records are public*." [Emphasis added]
The Federico *Commentary, etc.* has been cited by this Court on at least one occasion as apparently authoritative, *Aro Mfg. Co. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336 (1961) at 342, footnote 8, as well as on numerous occasions by the C.C.P.A. (most recently in *Solder Removal Co. v. Int. Trade Comm.*, 582 F2d. 628 at 633, 199 U.S.P.Q. 129 at 133, footnote 10).

[10] The proceedings are reported at 65 F.R.D. 171 et. seq.

Note *especially* the significant words "of course".

This Court is urged to grant certiorari herein as it did in the case of *Gannett Co., Inc. v. Hon. Daniel A. DePasquale*, No. 77-1301, where somewhat related issues are involved, although in a criminal context and on behalf of the press. In fact, a ruling favorable to the petitioner in that case now pending before this Court may well clearly indicate without more that the decision in the court below here was equally in error on the question of closure.

In *Sheppard v. Maxwell*, 384 U.S. 333 at 349 (1966), this Court noted that:

> The principle that justice cannot survive behind walls of silence has long been reflected in the 'Anglo-American distrust for secret trials'.

In *Landmark Communications, Inc. v. Virginia*, U.S. , 56 L.Ed.2d. 1 (May 1, 1978), this Court observed at page 10 that:

> The operations of the courts . . . are matters of utmost public concern.

There is an early English case having some aspects in common with this case. In *In re Lacy's Patent*, Chancery, July 25, 1816, 1 Abbott's Patent Cases 271 (Brodix, Washington, 1887), Lacy had invented a machine "for making French lace of the most beautiful texture". Application was made to the Court of Chancery "praying that his lordship would not put the great seal" to the patent because Lacy wanted to keep his specification secret for fifteen months. Lacy urged that if this specification was not kept secret the French might copy it; "but his lordship could not establish a new principle merely to prevent the French from smuggling; . . . "

A CONFLICT BETWEEN THE D.C. CIRCUIT AND THE C.C.P.A.

There is a strong likelihood of conflict between the present D.C. Circuit and the C.C.P.A. As already noted, *Drawbaugh* ruled squarely *against* secrecy of court records in a direct patent appeal of the very kind here involved. The jurisdiction formerly vested by statute in the *Drawbaugh* court in respect of direct patent appeals from the Patent Office has (since 1929) been vested in the C.C.P.A.[11] If the question of secrecy were *now* to be raised in a §145 civil action in the District Court as in *Isenstead, supra*, and were to be carried on appeal to the United States Court of Appeals for the District of Columbia Circuit[12], it is at least quite likely that that court would rule the same way as did its predecessor-in-jurisdiction, the *Drawbaugh* court, thereby creating a clear conflict in decisions by Article III appellate courts of equal stature.

This potential—perhaps probable—conflict should be settled by this court *in limine*.

PETITIONER HAS BEEN DEPRIVED OF A RIGHT GUARANTEED BY THE CONSTITUTION

The closure ruling in the court below violates rights *reserved to the people* by virtue of the Fifth and Ninth Amendments because not made pursuant to a specific grant of authority to the United States. Consequently, the decision in the case at bar violates petitioner's right of free and unrestricted access to the records and proceedings in the C.C.P.A., contrary to the necessary and obvious

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[11] The C.C.P.A. has been an Article III court since 1958. See 28 U.S.C. §211. In 1929 it acquired the jurisdiction over patent appeals formerly vested in the Court of Appeals of the District of Columbia. See the Act of March 2, 1929 (App.)

[12] The successor in name to the *Drawbaugh* court.

intendment of the Fifth Amendment, the Ninth Amendment, and the Tenth Amendment to the Constitution of the United States.

It is only in this Court that petitioner can secure the relief to which as a citizen of these United States he believes himself to be entitled.

PETITIONER SHOULD BE PERMITTED TO ATTEND THE HEARING IN *SARKAR*

As an alternative, it is respectively submitted that at the very least the petitioner should be permitted to attend the hearing when *Sarkar* is reached for oral argument in the C.C.P.A.

As this Court pointed out in *Craig v. Harney*, 331 U.S. 367 (1947) at 374:

> A trial is a public event. What transpires in the court room is public property.

The ruling of the court below cannot be reconciled with what this Court said in *Craig*.

A Suggested Form of Summary Relief for Petitioner

Precedent exists for this Court not only to take a lively interest in a case having trade secrets aspects such as this, but also where as here the issue is of a simplicity belying its importance, to dispose of it on the merits summarily. See *Spevack v. Strauss*[13] where this Court granted certiorari and at the same time *summarily* fashioned a remedy *per curiam*. 355 U.S. 601 (1958). During a later stage of that same proceeding this Court once again *summarily* fashioned a remedy, *per curiam*, in

[13] A case against the members of the United States Atomic Energy Commission.

response to another petition for writ of certiorari. See 359 U.S. 115 (1959).

It is therefore respectfully suggested that it would be entirely appropriate for the Court similarly to grant summary relief to petitioner here, without additional briefing and oral argument. The Court is urged to do so. In the event the Court sees fit to act on this suggestion, the authorities and arguments relied upon by the court below are dealt with at some length in Appendix G (App. 1g).

CONCLUSION

Petitioner respectfully urges the Court to hear this case on its merits by issuing a writ of certiorari to the United States Court of Customs and Patent Appeals.

Respectfully submitted,

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November 1978

APPENDIX

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE
PETITION
OF
ELLSWORTH H. MOSHER

DECIDED: August 24, 1978

Before MARKEY, Chief Judge, RICH, BALDWIN, LANE, and MILLER, Associate Judges

DECISION ON PETITION

PER CURIAM.

Ellsworth H. Mosher petitions the court to vacate its order sealing the record and providing for oral argument *in camera* in a patent appeal before this court, or, in the alternative, to authorize petitioner's presence during the oral argument in that appeal. The petition[1] is *denied*.

The appeal in question is presently pending, but has not yet been heard. Petitioner is not a party to the appeal and has alleged no special interest therein.[2]

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[1] Though the papers are designated as "motions," they constitute a petition and will be so designated here.

The clerk will return the $50 tendered by petitioner.

The record being sealed, petitioner was unable at the time of filing to accomplish service upon the parties. The Court declines petitioner's invitation to serve the petition upon the parties.

[2] The petition is assertedly filed in the public interest, not on behalf of any client, and not for the purpose of commercializing information learned upon granting of the petition.

Petitioner argues: (1) the public's right of access to court records is more important than that of an appellant to "cloak his activities * * * in secrecy;" (2) sealing the record in this appeal exposes the court to the future burden of innumerable motions to seal; (3) *Nixon* v. *Warner Communications, Inc.*, 98 S. Ct. 1306 (1978), is distinguishable, the tapes in *Nixon* having been played in public at trial, and the Presidential Recordings and Materials Preservation Act, Pub. L. 93-526, 88 Stat. 1695 (1974), having been referred to specifically in the Supreme Court's opinion; (4) CCPA Rule 5.13(g), authorizing *in camera* proceedings, is invalid, because, while 35 USC 122 of the Patent Act provides for retention of patent applications in confidence, §§141-144, governing review of Patent and Trademark Office (PTO) decisions, do not, and (5) *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470, 181 USPQ 673 (1974), is distinguishable because it involved trade secret misappropriation and whether state trade secret protection was preempted by federal patent law.

At common law, a member of the public may gain access to judicial records as a matter of right. *In re Motion of Mosher*, 45 CCPA 701, 704, 248 F.2d 956, 958, 115 USPQ 140, 141 (1957). Because our challenged prior order deprives petitioner of a right to which he would otherwise have been entitled, we assume, for purposes of this petition, that he has standing to challenge the order.

The actual target of the petition is CCPA Rule 5.13(g). That rule is merely declaratory of this court's inherent authority to protect the rights, including trade secret rights, of litigants. Petitioner fails to recognize that the public's right of access to court records does not in every instance override a litigant's claim to trade secret rights. In a free society, resting on a balance of individual rights and societal responsibilities, few if any rights are unlimited. Thus as was recognized in *Nixon*, *supra*, at

1312, the public's right of access to court records is not absolute.[3] Courts, both state and federal, have traditionally "refused to permit their files to serve * * * as sources of business information that might harm a litigant's competitive standing." *Id.* at 1312. *See also A. O. Smith Corp.* v. *Petroleum Iron Works Co. of Ohio*, 73 F.2d 531, 539 (CA6 1934) (case heard below *in camera*, no discussion of secret process in opinion on appeal, because of plaintiff's right to sealing of record at appellate level); *Isenstead* v. *Watson*, 157 F. Supp. 7, 8, 115 USPQ 408, 409 (D.C. D.C. 1957) (action against Commissioner of Patents under §145 held *in camera* on motion of applicant to protect secret product). State courts have traditionally held the public trial concept subject to the inherent power of the court to protect the rights of the parties, where the administration of justice so requires. *See People* v. *Jelke*, 308 N.Y. 56, , 123 N.E.2d 769, 772 (1959); *State* v. *O'Neill*, 273 Wis. 530, , 78 N.W.2d 921, 925-27 (1956) (writ of mandamus issued requiring trial court to take claimed trade secret evidence *in camera* and seal the record of the evidence so taken).

The silence of §§141-144 does not militate against this court's inherent authority to protect the trade secret and other rights of litigants as justice may require. Those sections, being part of Chapter 13 of Title 35, governing review of PTO decisions, are neither restricted nor controlled by the provisions of §122, a part of Chapter 11 of

[3] Petitioner's allegation that *Nixon* is inapposite is without merit. The statements relating to public access to judicial records in *Nixon* are reflective of existing law. That the Court's references to the Presidential Recordings and Materials Preservation Act bore no relation to trade secrets does not destroy its recognition that the public right of access to court records is less than absolute.

Title 35 governing applications for patent within the PTO.[4]

On the contrary, §122 and CCPA Rule 5.13(g) work together toward the goals of the patent system. Because of our prior order in the appeal in question, the appellate process will continue, keeping open the possibility that a patent may issue and that the public may thereby acquire full disclosure of the invention, including the trade secrets involved. An absence of Rule 5.13(g) would encourage, if not require, those who have disclosed trade secrets in a proffered exchange for the limited-term patent right to exclude others, to forego appeal and fall back upon the unlimited-term protection of trade secret laws, thereby denying the public early (or any) disclosure, and defeating the very purpose of the patent system.

In camera proceedings have been employed in §145 actions, brought by applicants against the Commissioner of Patents and Trademarks in the District Court, *Isenstead, supra*, and are contemplated by Federal Rule of Civil Procedure 26(c)(7) (1970), which reads in part:

> (c) Protective Orders. Upon motion by a party * * * and for good cause shown, the court in which the action is pending * * * may make any order which justice requires to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including * * * (7) that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way * * *.[5]

[4] Maintenance of confidentiality in the PTO is not premised on protection of trade secrets alone, but is designed to remove all impediments to early disclosure which would stem from an absence of confidentiality. Similarly, the power of a court to issue a protective order is not limited to protection of trade secrets, but encompasses removal of impediments to court access by parties as justice may require.

There is no substantive difference between proceedings held *in camera* under §145, and those held *in camera* under §141. Both extend the protection of the court to an applicant who has retained the subject matter of his application as a legitimate trade secret.

The analysis in *Kewanee, supra*, involved consideration of the purposes of the patent system, including disclosure of the invention in return for the limited term right of exclusion. That analysis was germane to the determination in our prior order that public disclosure of an appellant's trade secrets was not required in return for the right to appeal to this court and the consequent continuance of the quest for the patent right of exclusion.

Petitioner's solicitation and concern for the burdens upon this court, though laudable, are unfounded. Few appellants are in a position to present a proper case for sealing of the record. Many have commercialized their inventions prior to appeal; many will commercialize their inventions whatever the outcome of the appeal; and many have made their inventions known through publication. The subject matter of some inventions may become generally available through the activities of others. Those events, and others, may have rendered the involved information no longer susceptible of retention as a trade secret. Significantly, since January 1, 1974, when Rule 5.13(g) went into effect, there have been but two requests to seal the record.

Moreover, sealing of the record and oral argument *in camera* are exceptional actions, requiring strong

[5] The reference to trade secrets and other confidential commercial information added by the 1970 amendments was intended to reflect existing law. Notes of Advisory Committee on 1970 Amendment to Rules.

justification. We do not share the view that Rule 5.13(g) opens a Pandora's box, or that virtually each and every appellant will move the court to take those actions if the present petition is not granted. To take counsel of those fears would require a jaundiced, and unwarranted, view that frivolous motions for *in camera* proceedings would proliferate. It would further pre-suppose an inability of this court to summarily reject those expectedly rare requests. That a rule of court, like Rule 5.13(g), may be subject to abuse does not justify abandonment of the rule.

Accordingly, the petition is *denied*.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION OF CHIRANJIB K. SARKAR	Appeal No.	78-554.
	On motion to seal record and for *in camera* proceeding.	
	Serial No.	445, 765.

DECIDED: May 11, 1978

Before MARKEY, Chief Judge, RICH, BALDWIN, LANE, and MILLER, Associate Judges.

ORDER

PER CURIAM.

Appellant Sarkar moves the court pursuant to CCPA Rule 5.13(g) to seal the record in Appeal No. 78-554 and to hear oral argument with respect thereto *in camera* so that material disclosed in the involved patent application may be retained, in the event of an adverse decision, as a trade secret. Having considered memoranda stating the views of the parties, the motion is *granted*.

FACTS

February 13, 1978, Sarkar filed with the Clerk of this court the certified transcript of the proceedings in the Patent and Trademark Office (PTO) with respect to his pending patent application, which proceedings had culminated in an adverse decision of the Board of Appeals (board), on all pending claims, from which a timely appeal

had been taken under 35 USC 141. Sarkar's claimed invention involves a technique for "modeling" a river on a computer so that design requirements of riparian constructions can be accurately predicted. The board held that the claimed method embodying such a technique was not statutory subject matter under 35 USC 101 as construed in *Gottschalk* v. *Benson*, 409 U.S. 63 (1972). The controlling legal principles are, as yet, unsettled, and, at this time, the Supreme Court is again considering the status of computer-software inventions as statutory subject matter in *Parker* v. *Flook*, *cert. granted*, U.S. , 196 USPQ 864 (1978) (Appeal No. 77-642, argued April 25, 1978).

Concurrent with the filing of the transcript, Sarkar filed with the Clerk of this court the instant motion praying, inter alia, that the record be sealed. Upon receipt of these papers, the Clerk docketed Sarkar's appeal and took steps to preserve the secrecy of the materials contained in the transcript pending disposition of this motion. As a result, the papers constituting the record in this appeal have never been available to the public. *Cf. In re Mosher*, 45 CCPA 701, 248 F.2d 956, 115 USPQ 140 (1957). In the PTO, they were, presumably, held in confidence in accordance with 35 USC 122.

It is alleged that certain mathematical formulae involved in the claimed method have been retained as, and are now, valuable trade secrets, and it is argued that disclosure and attendant loss of such secrets in the course of obtaining jud' ·ial review of the PTO decision would be unjust. Attempts to enter into a stipulation with the PTO solicitor whereby an abbreviated record might have been brought publicly before this court have met with no success. Accordingly, relief has been sought under our Rule 5.13(g) which reads:

> (g) *In Camera* Proceeding. In a proper case, where the interests of justice require, and on a convincing showing thereof by motion properly made, the court will sit *in camera*, or seal its record, or both.

The PTO opposes the motion on public policy grounds, saying "A resolution, one way or the other, will have no effect on the Patent and Trademark Office," alleging that the showing made is insufficient to warrant the relief sought. The solicitor notes that Sarkar was granted a license under 35 USC 184 to file similar applications abroad and that Sarkar had failed to show that no foreign application filed thereunder was now open to the public. This court's decision in *In re Sackett*, 30 CCPA 1214, 136 F.2d 248, 57 USPQ 541 (1943), is cited for the proposition that the right of public access to court records is paramount to a patent applicant's claim to trade-secret rights.

In reply, Sarkar assures the court that no foreign applications have been filed and that there has been no public disclosure of the alleged trade secrets.

RESOLUTION

This is a case of first impression in this court with respect to which our prior decisions offer no guidance. *Sackett* does not support the proposition urged by the PTO. There, the appellant sought review of a board decision and, *after* the court's decision affirming the board had been rendered, moved the court to seal the record so that the substance of the patent application could be retained as a trade secret. The court denied the motion noting that once appellant had openly and voluntarily brought the alleged invention into the public forum of the court, the court was not (meaning no longer) authorized to protect it as a trade secret. Sarkar's concurrent filing of this motion and the certified transcript effectively avoids the *Sackett* problem.

Any federal court has the *inherent authority* to seal its record when, in the exercise of sound discretion, such action is deemed appropriate. See *Nixon* v. *Warner Communications, Inc.*, 46 U.S. L.W. 4320 (U.S. April 18, 1978) (Appeal No. 76-944). Our Rule 5.13(g) is merely declaratory of this inherent authority never before exercised by this court to protect a trade secret in an ex parte patent appeal.

The determination of what constitutes a "proper case" in which to seal our record requires balancing the triangular interests of the trade secret owner, the court as an institution, and the public. The factors present in this case which lead us to the conclusion that the motion should be granted are:

(1) The substance of the patent application in issue has remained confidential by virtue of the operation of 35 USC 122;

(2) The filing of the instant motion *coincided* with the filing of the certified transcript in this court such that the latter was never available to the public;

(3) The motion and supporting memoranda convincingly demonstrate (a) that the application in issue contains material susceptible of retention as a trade secret, (b) that such material has, in fact, been so retained, (c) that appellant has filed no foreign patent applications, and (d) that the subject matter has not become generally available through the activities of others;

(4) The merits of appellant's claim of entitlement to patent protection involve unsettled questions of law which are of current concern and the resolution of which is in the public interest;

(5) All less restrictive mechanisms for bringing the dispute before this court while still protecting the alleged trade secrets, e.g., a stipulated statement of facts, an abbreviated record, etc., have been explored and proven impractical; and

(6) The extraordinary action of the court in protecting the substance of the pending application will not be rendered nugatory by the issuance of a patent *regardless* of our holding since there are no allowed claims based on the alleged trade secret pending in Sarkar's application.

We are guided in our determination by the opinion of the Supreme Court in *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470, 181 USPQ 673 (1974), from which we glean the sentiment that, wherever possible, trade secret law and patent law should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest before this court for resolution. By extending the protection of the court to the *legitimate* trade secret under conditions such as those outlined above, we believe that conflicts between the two systems will be minimized.

It is, therefore, ORDERED that the MOTION FOR *IN CAMERA* PROCEEDINGS and TO SEAL THE RECORD is *granted* to the extent that the record, briefs, and other papers in this appeal shall remain confidential and only the parties to this appeal, their counsel, and necessary court personnel shall be permitted to be present at any oral argument. The court reserves the right to articulate the bases of its decision as it deems necessary.

GRANTED

**IN THE UNITED STATES COURT
OF CUSTOMS AND PATENT APPEALS**

IN RE MOTION BY
ELLSWORTH H. MOSHER **Special C.C.P.A. Docket No.**

MOTION UNDER RULE 5.3 TO VACATE OR OVERRULE *In re Sarkar* DECIDED May 11, 1978, OR FOR OTHER RELIEF

To the Honorable, the Chief Judge and the Associate Judges of the United States Court of Customs and Patent Appeals:

Now comes ELLSWORTH H. MOSHER, a member in good standing of the Bar of this Court, and respectfully moves the Court for an Order vacating or overruling the decision of the Court dated May 11, 1978, by which the record, etc., in the case of *In re Sarkar*, C.C.P.A. Docket No. 78-554, was sealed, so that the undersigned may thereafter secure copies of portions of the record therein.

Alternatively, the undersigned respectfully moves the Court for an Order modifying the aforesaid decision in *Sarkar* at least to the extent of

(a) authorizing the undersigned to be present during the oral argument in *Sarkar*, and

(b) instructing the Clerk of the Court to give the undersigned reasonable notice in advance of the date set for the oral hearing in *Sarkar*.

A supporting brief and the docketing fee of fifty dollars ($50.00) are attached hereto, as well as appropriate Orders.

Respectfully submitted,

Ellsworth H. Mosher
1911 Jefferson Davis Highway
Suite 600, Crystal Mall 1
Arlington, Virginia 22202
Telephone (703) 920-8900

June 8, 1978

STATEMENT IN LIEU OF CERTIFICATE OF SERVICE

It is appreciated that Rule 5.3 requires that a motion of this kind be served on the opposing party. However, since not only the record but also the briefs in *Sarkar* have been sealed, the undersigned has no knowledge of the address of Sarkar or his counsel. Accordingly, extra copies of this motion (with supporting brief and orders) are attached hereto so that the Clerk of the Court may, if he be so advised, serve copies on the appropriate individuals.

Ellsworth H. Mosher

[LETTERHEAD]
June 8, 1978

Clerk
United States Court of
Customs and Patent Appeals
717 Madison Place, N. W.
Washington, D.C. 20439

Re: In re Sarkar—C.C.P.A. Docket No. 78-554

Sir:

Please provide the undersigned with a certified copy of the appellant's application as filed, from the record in the above-identified appeal. A certified check in the sum of fifty dollars ($50.00) is attached hereto to cover the cost of the certified copy.

CAUTION: This order for certified copies must not, and cannot, be filled unless and until the Court vacates or overrules the Order of May 11, 1978 sealing the record in *Sarkar*.

Respectfully submitted,

ELLSWORTH H. MOSHER

EHM:mmh
Enclosure

THE CONSTITUTIONAL, STATUTORY AND RULE OF COURT PROVISIONS INVOLVED

In pertinent part, the constitutional provisions involved here are the following:

From the First Amendment:

Congress shall make no law... abridging the freedom of speech, or of the press; ...

From the Fifth Amendment:

No person shall... be deprived of... liberty ... without due process of law...

From the Ninth Amendment:

The enumeration in the Constitution, of certain rights, shall not be construed to deny or disparage others retained by the people.

From the Tenth Amendment:

The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people.

The statutory provisions are the following:

From the Act of July 4, 1836, 5 Stat. 117, §16:

§ 16. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; ...

From the Act of March 3, 1839, 5 Stat. 353, §11:

§ 11. And be it further enacted, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, . . .

From the Act of March 2, 1929, Public No. 914, 70th Congress, §2.(a):

§ 2.(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trademark cases is vested in the United States Court of Customs and Patent Appeals.

28 U.S.C. §211. Appointment and number of judges

The President shall appoint, by and with the advice and consent of the Senate, a chief judge and four associate judges who shall constitute a court of record known as the United States Court of Customs and Patent Appeals. Such court is hereby declared to be a court established under article III of the Constitution of the United States. As amended Aug. 25, 1958, Pub.L. 85-755, §1, 72 Stat. 848.

28 U.S.C. §1256: Court of Customs and Patent Appeals; certiorari

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari. June 25, 1948, c. 646, 62 Stat. 928

28 U.S.C. §2071: Rule-making power generally

The Supreme Court and all courts established by Act of Congress may from time to time prescribe rules for the conduct of their business. Such rules shall be consistent with Acts of Congress and rules of practice and procedure prescribed by the Supreme Court. June 25, 1948, c. 646, 62 Stat. 961; May 24, 1949, c. 139, §102, 63 Stat. 104.

35 U.S.C. §122: Confidential status of applications

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. As amended Jan. 2, 1975, Pub.L. 93-596, §1, 88 Stat. 1949.

35 U.S.C. §§141-144:

§141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States court of Customs and Patent appeals, but such appeal shall be dismissed if any adverse party to such

interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. July 19, 1952, c. 950, §1, 66 Stat. 802.

§142. Notice of Appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. As amended Jan. 2, 1975, Pub.L. 93-596, §1, 88 Stat. 1949.

§143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent and Trademark Office, in writing, touching all the points involved by the reasons of appeal. As amended Jan. 2, 1975, Pub.L. 93-596, §1, 88 Stat. 1949.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern the further proceedings in the case.
As amended Jan. 2, 1975, Pub.L. 93-596, §1, 8 Stat. 1949.

The court rules involved are the following:

C.C.P.A. Rule 1.2(b):

"Records. The clerk shall have custody of the records of the court . . . Any person may, except where restricted by law or where the court otherwise directs, have access to such records [see 28 U.S.C. 2637]. Copies thereof may be obtained on payment of prescribed fees set by the court."

C.C.P.A. Rule 5.13(g):

"*In Camera* Proceedings. In a proper case, where the interests of justice require, and on a convincing showing thereof by a motion properly made, the court will sit *in camera*, or seal its record, or both."

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN RE PETITION OF
ELLSWORTH H. MOSHER

MOTION FOR A STAY OF FURTHER PROCEEDINGS IN *IN RE SARKAR*

To the Honorable, the Chief Judge and the Associate Judges of the United States Court of Customs and Patent Appeals:

Now comes your petitioner, Ellsworth H. MOSHER, and respectfully moves for a stay of further proceedings in this Court in the matter of *In re Sarkar*, Appeal No. 78-554. Petitioner is now preparing a petition for certiorari to the Supreme Court of the United States to review this Court's decision in *In re Mosher*, F.2d , 199 U.S.P.Q. 82 (1978), relative to the correctness of sealing the record in *Sarkar* and in ordering an *in camera* oral hearing in the appeal therein, and is filing the instant motion in order to stay further proceedings in *Sarkar* (thereby preserving the *status quo*) pending a decision of the Supreme Court on the petition for certiorari.

It is respectfully submitted that this Court should take no further action in *Sarkar* that might risk mooting what petitioner believes to be either of his two rights asserted in his original petition—rights which he is still entitled to pursue via timely petition for certiorari—and which further action by this Court might place beyond the power even of the Supreme Court fully to vindicate in the event that Court should agree with petitioner's position.

Early and favorable action on this motion is earnestly solicited. Since this Court declined to serve the original petition upon the parties (F.2d , 199 U.S.P.Q. at 83, footnote 1) it is assumed that despite Rule 6.2 this motion likewise need not be served, since no mandate was issued.

Respectfully submitted,

_____

Charles A. Wendel

_____

Harold C. Wegner

Attorneys for Petitioner
1911 Jefferson Davis Highway
Suite 600, Crystal Mall 1
Arlington, Virginia 22202
Telephone (703) 920-8900

November 1, 1978

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
717 MADISON PLACE NW.
WASHINGTON, D.C. 20439

GEORGE E. HUTCHINSON
CLERK

TELEPHONE: 347-1552
AREA CODE 202

November 2, 1978

Mr. Charles A. Wendel
Stevens, Davis, Miller and Mosher
1911 Jefferson Davis Highway
Arlington, Va. 22202

Re: In the Matter of the Petition of Ellsworth H. Mosher

Dear Sir:

The court today denied the motion of Ellsworth H. Mosher for a stay of further proceedings in this court in In re Sarkar, Appeal No. 78-554.

FOR THE COURT

Clerk

m
CC: Mr. Harold Wegner

THE AUTHORITIES AND ARGUMENTS RELIED UPON BY THE COURT BELOW

In granting and then later sustaining the original ruling on Sarkar's motion, it appears (App. 4b) that considerable reliance was placed upon *Nixon v. Warner Communications, Inc.*, U.S. , 98 S.Ct. 1306, 55 L.Ed.2d 570 (1978). However, Mr. Justice Powell's opinion for the majority points out that the respondents wished to copy certain of the Watergate tapes "for broadcasting and sale to the public" (55 L.Ed.2d at 575). The majority opinion (at page 577) makes it clear that the tapes had already been "played for the jury *and the public* in the courtroom". The District Court had

> "furnished the jurors, reporters, and *members of the public in attendance* with earphones and with transcripts prepared by the Special Prosecutor" [Emphasis added].

Although the transcripts themselves had not been admitted in evidence, the Court pointed out that these had been "widely reprinted in the press".

Therefore—unlike the situation in *Sarkar*—the subject matter of the Watergate tapes had *already* been widely disseminated to the public, and so the only question remaining was whether for purely commercial reasons the respondents should be permitted to "copy, broadcast, and sell to the public the portions of the tapes *played at trial*" [emphasis added].

Sealing of the record, in the sense of the present petition, simply was not an element of the *Nixon* case.

Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974), was relied upon by the court below (App. 5b), but the facts of that case are not such as to render it of much value as a

guide in the present situation. Kewanee was a simple case of trade secret *misappropriation* to which was superadded the question of whether Ohio state trade secret protection was pre-empted by operation of the federal patent law (416 U.S. at 472). No such considerations are present here, where there are no questions of trade secret misappropriation or pre-emption of the laws of one governmental entity (Ohio) by the laws of another governmental entity (the United States).

In P.J. Federico's *Commentary on the New Patent Act*, 35 U.S.C.A. 1 et seq. (1954), he notes at page 5 that

> "[f]rom 1874 to 1952 over sixty Acts of Congress relating to patents have been passed; . . ."

This shows that the Congress has had ample *opportunity* over the years to express a different intent as to secrecy of court records in the C.C.P.A., had it wished to do so. If anything, therefore, petitioner's position is *fortified* rather than otherwise by *Kewanee*. See the passage, at page 493 of 416 U.S., reading as follows:

> "Congress, *by its silence over these many years*, has seen the wisdom of allowing the States to enforce trade secret protection. *Until Congress takes affirmative action* to the contrary, States should be free to grant protection to trade secrets." [Emphasis added]

Transposing this principle to the present case, and since (as noted by Federico) the Congress has seen fit to amend and/or revise the patent laws in other respects dozens of times over the last century without once[1] expressing any

[1] Of course secrecy is provided for in other contexts having nothing to do with the present case. See 35 U.S.C. §181 relative to patent applications for inventions involving the *national security*, and §184 on the requirements for licensing for *foreign filing* on inventions made in the United States. Although the contexts in those situations are

(footnote continued)

legislative intent with respect to secrecy of patent applications *except* while they remain within the Patent Office (35 U.S.C. §122), the conclusion seems inescapable that the Congress "by its silence over these many years" adheres to the wisdom of continuing to allow the records in the files of the C.C.P.A. in a direct appeal from the Patent Office to be freely available to the public, *as they always have been in the past.*

The citation by the C.C.P.A. (App. 3a) of the Sixth Circuit case of *A. O. Smith Corp. v. Petroleum Iron Works Co.*, 73 F.2d 531 (6 Cir., 1934), does not support the denial of access to court records, etc., *in the C.C.P.A.* That case was nothing more or less than an ordinary patent infringement and trade secrets case. It has nothing whatsoever to do with proceedings on the part of a patent applicant *hoping ultimately to obtain a patent.*

Petitioner makes no contention that the sealing of the record in an ordinary garden variety patent fringement and trade secrets case is improper, so far as trade secrets *per se* are concerned. The gravamen of the action in such a case is different in kind from that involved in the present petition because it does not—and can not—include an attempt to *obtain* a patent.

Similar remarks apply to the citation by the C.C.P.A. (App. 3a) of *Jelke* and *O'Neill*, both state cases. *People v. Jelke*, 308 N.Y. 56, 123 N.E.2d 769 (1959), was a case where in order to "protect" a witness in a case involving obscene and sordid details, the trial judge closed the trial to the public during the People's case *but opened it to the public during the defense.* It had nothing to do with trade

(footnote continued)

entirely different, the very fact that the Congress included those additional secrecy provisions in the Patent Act of 1952 still further fortifies petitioner's contention that the *absence* of any comparable provisions in §§141-144 should be regarded as significant—and indeed controlling here.

secrets. The state court there pointed out an important distinction in cases of this general character:

> "There is, however, a vast difference between a trial of that kind, to which *everyone is admitted except* a designated few, and one, as in the case before us, from which *everyone is excluded but* a limited class." [Emphasis in the original] (p. 774 of 123 N.E.2d).

State [*ex. rel. Ampco Metal, Inc.*] *v. O'Neill*, 273 Wisc. 530, 78 N.W.2d 921 (1956), was a quite ordinary trade secrets case in a state court with of course no aspect of an attempt to *obtain* a patent.

The reference to the Federal Rules of Civil Procedure in the opinion of the C.C.P.A. (App. 4a) is "inapposite". In *United States v. Torch Manufacturing Co., Inc.*, 509 F.2d 1187 (1975), *the C.C.P.A. itself* noted at page 1192, footnote 8, that

> "[a]ppellee's citation to the Federal Rules of Civil Procedure is *inapposite* inasmuch as they are expressly made applicable to the United States district courts only." [Emphasis added]

The C.C.P.A. made some point of the fact that §122 of the new Patent Act and §§141-144 are in different "chapters" of the Patent Act of 1952 (App. 3a). However, this overlooks the fact that the Patent Act of 1952 was enacted *as an entirety*.[2] As stated at 82 C.J.S. pp. 694-698 (omitting footnotes):

> "All parts, provisions, or sections of a statute or section, must be read, considered, or construed together, and each must be considered with respect to, or in the light of, all the other provisions or sections, and construed in connection, or harmony, with the whole. So, in determining the meaning of a particular word, phrase, or clause as used in a statute, *the entire statute is to be considered.*" [Emphasis added]

[2] See Federico, *Commentary*, supra, at page 9.

That same authority also states (pages 691-3) that,

> "In the absence of express statutory language to the contrary, a statute must, or should, be read or construed as a whole, or in its entirely, and, *with respect to the construction of a statute, its division into sections is a purely artificial and unessential arrangement.*" [Emphasis added.]

Finally, the C.C.P.A. (App. 5a) remarked on the fact that since its Rule 5.13(g) went into effect nearly five years ago, only two requests to seal the record have been made. However if, as petitioner respectfully contends earlier, the C.C.P.A. has no *authority* to seal its records, etc., it is quite immaterial whether there are only two such instances or whether they number in the hundreds. Moreover, so far as the implied ability of the C.C.P.A. to control the situation[3] by the proper exercise of *discretion* under its Rule 5.13(g) is concerned, petitioner's high regard for the court below makes it easy for him to concede the point if the point were relevant. The relevant point at issue here is not the lower court's discretion, but its *authority*. Stated plainly and simply, petitioner contends that the C.C.P.A. does not have the necessary authority.

[3] *Quare:* Speaking of control, how could the court below ever justify a denial of a motion to seal, etc., presented in the future by *each* of appellants A, B, C, . . . X, Y, Z based solely upon a mere showing of the presence of trade secrets in their respective patent applications, but without any showing of special circumstances *other* than trade secrecy? Would not a denial under such circumstances be a constitutionally impermissible discriminatory action forbidden by the Fifth Amendment?